

REMARKS

Status of Claims

Claims 1 – 43 were previously cancelled. Claims 44 – 123 are currently pending, and stand rejected at the present time. Without prejudice to future claims of patentability, the following claims were withdrawn on December 17, 2007: 52- 55, 58, 77, 78, 83, 90, 105 – 108, 111 and 118.

Of the pending claims, Claims 44 and 99 are independent claims. Claims 45 – 98 depend upon Claim 44, and claims 100 - 123 depend upon Claim 99.

New claims 124 – 133 are presented, and find support throughout the Specification and the drawings. As these new claims are within the same category as pending claims 44 – 123, an additional search is not necessary, as the Office’s prior search efforts would necessarily include art areas for these claims. The new claims assert a third independent claim for this application, and nine new defendant claims for this application, so that only fees for the eight defendant claims are submitted with this Response.

Rejections Pursuant to 35 U.S.C. § 112

The Office rejects claims 44 -51, 56 57, 59 – 64, 66 – 76, 80 – 82, 91 – 104, 109 – 110, 112 – 117 and 119 - 123 pursuant to 35 U.S.C. 112 as being “replete with unclear language.” The Office states “Some examples include:” (4/9/08 OA, p. 3), but fails to identify every “example”, which makes it impossible for the Applicant to address every “example”, but the Applicant has nevertheless attempted to review the claims for any language which may need additional clarification.

If a Section 112 rejection is asserted, it is incumbent upon the Office to specifically identify whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. See MPEP § 2171.

Under this section of rejections, the Office initially states that the term “introducing” in Claim 44 is “unclear” (in this regard, the actual phrase found in Claim 44 is “Introducing at least one core computer system communicatively compatible with a customer and with other computers communicating with the core computer system [...]”). The use of the term “introducing” is common in patent claim drafting practice, exists in numerous U.S. patent registrations, is definite, and is an allowable term for process or method claims. When viewed in this light, Section 112 requires that the patent claims point out the subject matter which the applicant regards as his invention, implementing the purpose of claims to identify what has been invented and found patentable, so that one skilled in the art would understand the bounds of the claim when read in light of the specification. *See Pharmastem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1373 (Fed. Cir. 2007); *see also Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) (“If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.”); *see also Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385 (Fed.Cir.1986) (“if the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand

no more' "); *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) ("if the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds"). As applied to the present invention, the phrase "Introducing at least one core computer system communicatively compatible with a customer and with other computers communicating with the core computer system [...]" refers to identifying, bringing into play or using at least one core computer system which may communicate with a customer or other computers. Support for this phrase is found throughout the specification. Also, as stated by the Federal Circuit:

In short, the specification makes clear that in drafting his claims, when the patentee used the word "providing"-a word that like "introduc[ing]" or "supplying" denotes the addition of a separate substance into the stent-he did so deliberately, and not through an accident of quirky or idiomatic usage. This conclusion can be drawn from the fact that when he meant to convey the preexistence of a material in the sleeve he used an appropriate verb, such as "contain[ing]."

Arlaine & Gina Rockey, Inc. v. Cordis Corp., 175 Fed. Appx. 329, 332 - 333 (Fed. Cir. 2006) (citations omitted). Thus, the Applicant submits that the term "introducing" is firm and definite.

Next, the Office states that Claims 49, 57, 64 and 97 contain an improper Markush grouping. Claims 57, 64, 82, 89 110 and 117 have been amended in this Response in order to clarify the Markush grouping (such groupings being recognized for method or process claims in accordance with MPEP § 803.02). However, Claims 49 and 97 are not claims subject to a Markush grouping, as those claims identify the various technologies in which the claimed electronic means may communicate (e.g., by voice synthesizer transmission, by audio transmission, by audio-visual transmission, by radio frequency transmission). *See* MPEP 2173.05(h) ("Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims."). As such, Claims 49 and 97 were not amended to a Markush grouping.

Next, the Office asserts that the phrase "any tenant" in Claim 50 lacks antecedent basis¹. The Office did not suggest any corrections to this phrase. MPEP § 2173.05(e). However, the phrase "any tenant" does not require antecedent basis as this is the first time this phrase appears in the claim set,. Moreover, this phrase is definite, as it refers to "several types of retail or commercial tenants [housed] within the same structure", which upon reading the Specification, is a phrase which is reasonably ascertainable by those skilled in the art. *See e.g.*, Specification, ¶¶ 0018, 0053, 0054, 0063, 0081; *see also* MPEP § 2173.05(e). Moreover, the terms "tenant" or "tenants" are expressly defined in the Specification. *See e.g.*, Specification, ¶ 0053.

¹ The Office also states that the phrase "at least one tenant" lacks antecedent basis in Claim 50. Upon inspection, Claim 50 does not contain the phrase "at least one tenant". Claim 55 does contain this phrase. This phrase is definite, as it refers to one or more "types of retail or commercial tenants [housed] within the same structure", which upon reading the Specification, is a phrase which is reasonably ascertainable by those skilled in the art. *See* Specification, ¶¶ 0018, 0053; *see also* MPEP § 2173.05(e).

In light of the foregoing, reconsideration of the Office's Section 112 positions is respectively requested.

Rejections Pursuant to 35 U.S.C. § 103 (Kipp in view of Domain)

The Office rejects Claims 44 – 51, 56 – 57, 59 – 61, 66 – 76, 80 – 82, 84 - 85, 91 – 104, 109, 110,, 112 – 114 and 119 – 123 as being unpatentable over U.S. Patent No. 5,890,136 to Kipp (the "Kipp patent") in view of U.S. Patent No. 5,158,155 to Domain et al. (the "Domain patent").

To determine obviousness, the Federal Circuit requires the Office to establish "some teaching, suggestion, or motivation to combine the [prior art] references.". *In re Rouffet*, 149 F.3d 1350, 1355 (Fed.Cir.1998). However, "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Moreover, "[w]hen the art in question is relatively simple[,] the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001). In these situations, the need for the Office to particularly specify where the teaching, suggestion or motivation to combine references is absolute, so that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). As a consequence, the Office is required to specifically identify where the teaching, suggestion or motivation arises in the prior art to support a claim of obviousness. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). This identification "must be clear and particular, and it must be supported by actual evidence." *Group One Ltd. V. Hallmark Cards, Inc.*, 407 F.3d 1297 (Fed. Cir. 2005). A mere conclusory statement that the one of skill in the art would have the knowledge to combine references "does not in and of itself make it so, absent clear and convincing evidence of such knowledge." *Smiths Ind. Med. Systems, Inc. v. Vital Signs, Inc.*, 50 U.S.P.Q.2d 1641 (Fed. Cir. 1991).

Examining the Kipp patent closely, the Kipp patent discloses a retail store system which includes four primary, but separate, components, namely:

- (i) an interactive system for communicating a customer's order (Kipp patent, Cols. 4 - 5, ll. 62 - 38);
- (ii) a host computer to receive and process a customer's order (*Id.*, Col. 5, ll. 38 - 64);
- (iii) a system for retrieving articles (*Id.*, Cols. 5 - 6, ll. 65 - 38); and
- (iv) a system for retrieving identification information from the customer (*Id.*, Cols. 6 - 7, ll. 39 - 7).

These four separate components are also expressly described in the Kipp patent at, for example, Col. 3 - 4, ll. 9 – 33; Col. 4, ll. 50 – 61; and the Kipp patent, Claims 1 and 6. Each of these recitations directly teach away from the recitations of the present Claims 44 and 99, as illustrated below. Indeed, several exemplary disadvantages of the Kipp patent were already disclosed in the present Specification as filed at ¶ 0015.

Unlike the Kipp patent's requirement of multiple, separate components, neither independent Claims 44 nor Claim 99 of the present invention require separate systems for obtaining a customer's order, for retrieving any articles orders, and for retrieving identification information from the customer. Rather, the present invention's core computer system is a fully integrated (and single) system adapted to collectively obtain, process and track orders, retrieve goods or serviceable items corresponding to the orders, deliver the goods or serviceable items to the customer at a predefined drive-thru pick up area, and optimize the traffic flow for optimized delivery of the goods or serviceable items to the delivery in the drive-thru pick up area. The present invention achieves, in one core computer system, what Kipp requires through four separate systems. Because as a whole, the present invention is not inherently or expressly taught or suggested by any language in the Kipp patent, and because the Kipp patent teaches away from the present invention, the Kipp patent cannot obviate any claim in the present invention. See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 (Fed. Cir. 2004) (in assessing Section 103 rejections, Section 103 “specifically requires consideration of the claimed invention as a whole” and “prevents evaluation of the invention part by part.”).

In sum, while the Kipp patent discloses multiple, separate systems in order to achieve an automated retail store, the present invention only requires a single system. This necessarily means that the present invention achieves additional advantages over the Kipp patent, such as a savings of money and resources (since only a single computer system is required). Indeed, the only disclosed function of Kipp's host computer system is to receive and process a customer's order and maintain inventory (Kipp patent, Col. 5, ll. 47 – 60), so that Kipp expressly teaches away from the present invention.

In light of the foregoing analysis, the Kipp patent necessarily fails to obviate the rejected independent claims (*i.e.*, Claims 44 and 99), and those claims which depend on these claims (*i.e.*, pending claims 45 - 98, and 100 - 123).

Reconsideration is respectfully requested.

Rejections Pursuant to 35 U.S.C. § 103 (Kipp in view of Domain)

As identified above, the Kipp patent fails as an obviating reference under Section 103 to all of the pending claims. The Office next applies the Domain patent to “fill the gap” not found in the Kipp patent, namely, a computer which is adapted to optimize traffic flow through the drive-thru pick up area.

It is legally impermissible “simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's

combination would have been obvious.” *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991); *see also Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”) (citation omitted).

Importantly, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Here, the Office provides a general conclusion that “At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a computer-controlled traffic optimization system, as taught by Domain, in Kipp’s drive-through retail facility, for the purpose of optimizing traffic.” *See* 4/9/08 OA, p. 4, ¶ 16. There are several problems with this analysis. For example, the Kipp patent fails as an obviating reference to the present invention, so that the combination of the Kipp patent with the Domain patent must also fail as obviating references. *See In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994) (references that teach away cannot serve as evidence of obviousness). Next, the Office fails to identify any portion of either the Kipp patent or the Domain patent in which one of skill in the art would have the motivation to combine the two references to achieve the present invention. *See In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998) (“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness[. This requirement] stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.”). Additionally, the Office’s general conclusion is legally impermissible, because the only way this combination might exist is if the Office used the present application as the blueprint to make this combination. *See In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991) (“It is impermissible, however, simply to engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.”).

Moreover, there are other distinctions present between the present invention and the Kipp patent. For example, the Kipp patent expressly teaches a fixed drive-up structural configuration which lacks the flexibility of high traffic throughput needed for high volume purchases by customers or the associated high traffic which occurs during peak sales periods. *See e.g.*, Kipp patent, Figures 5, 6, element 14. The present invention discloses a novel system which is adapted to adjust and accommodate such traffic requirements in a substantially real-time basis. Additionally, the Kipp patent only discloses that a consumer can order articles remotely (*Id.*, Col. 5, ll. 13 – 25), and completely fails to appreciate that such articles can also be ordered on-site, as recited in the present invention, a distinction which benefits the consumer. And, the present invention is not limited to a “quick stop” visit by a consumer; rather, the present invention’s use of computer technology and traffic control technology allow consumers to leisurely take their time when ordering and/or retrieving goods or services from the facility. Additionally, the present invention also allows for the ordering and/or retrieval of serviceable items (such as banking, dry cleaning, etc.), a recitation that is noticeably absent in the Kipp patent.

Because the Office fails to identify any teaching, suggestion or motivation in the Domain patent which would allow one of skill in the art to combine the Domain patent with the Kipp patent to achieve the present invention, this rejection for all pending claims must be withdrawn.

Reconsideration is respectfully requested.

Rejections Pursuant to 35 U.S.C. § 103 (Kipp in view of Dickson)

The Office next applies the Dickson patent to “fill the gap” of the present invention that the Kipp patent expressly fails to disclose a structure having a pre-defined food pickup area as recited in Claims 62 – 64, 86 – 89, and 115 – 117. Again, the Office provides a general conclusion that because the Dickson patent discloses a food prep area for the purpose of expanding retail offerings in order to increase sales and thus profits”, “At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added a food area with food prep area, such as a restaurant, as taught by Dickson, in Kipp’s drive-through retail facility, for the purpose of expanding retail offerings and increasing profits.” *See 4/9/08 OA, p. 6, ¶¶ 27 – 28.*

Similar to the analysis above, the Office’s position is not supported for numerous reasons. Again,, because the Kipp patent fails as an obviating reference to the present invention, the combination of the Kipp patent with the Dickson patent must also fail as obviating references. Next, the Office fails to identify any portion of either the Kipp patent or the Dickson patent in which one of skill in the art would have the motivation to combine the two references to achieve the present invention. Additionally, the only way the Office can combine the Kipp patent with the Dickson patent to “fill the gaps” is if the Office used the present application as the blueprint to make this combination, which results in hindsight reasoning, which is not permitted.

Because the Office fails to identify any teaching, suggestion or motivation in the Dickson patent which would allow one of skill in the art to combine the Dickson patent with the Kipp patent to achieve the present invention, this rejection for all pending claims must be withdrawn.

Reconsideration is respectfully requested.

Conclusion

In light of the foregoing amendments and remarks, Entry of the foregoing amendments is respectfully requested. The undersigned would welcome a phone call from the Office to expedite the resolution of this application. A return postcard is attached, which the Applicant requests the Office to stamp and mail to the Applicant. The Applicant further submits a Combined Amendment & Petition for Extension of Time (requesting extension of time from July 9, 2008 [the date corresponding to a response due to the April 4, 2008 Office Action] to August 9, 2008). The Applicant further submits a check for \$260 covering the fees for an additional eight (8) dependent claims (\$200) and \$60 to cover the one month petition fee.

Respectfully submitted,

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